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AF-SW

In re Application of: ) Art Unit: 1645  
BIRKELUND, et al. ) Examiner: SHAHNAN SHAH, K.  
Serial No.: 09/446,677 ) Washington, D.C.  
Filed: March 24, 2000 ) August 30, 2004  
For: NOVEL SURFACE EXPOSED ) Docket No.: BIRKELUND=1  
PROTEINS FROM CHLAMYDIA )  
PNEUMONIAE ) Confirmation No.: 2720

REQUEST TO VACATE OR SUPPLEMENT INCOMPLETE OFFICE ACTION  
OR WITHDRAW FINALITY OF ACTION

U.S. Patent and Trademark Office  
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Arlington, Virginia 22202

S i r :

The Commissioner is requested to exercise his supervisory authority under 37 CFR 1.181 by (1) vacating the final action mailed October 23, 2004, and directed the examiner to issue a new, complete action in its stead, or (2) directing the examiner to supplement the October 23 action and restart the period for response or (3), if neither (1) or (2) is possible, withdrawing the finality of the October 23 action.

37 CFR 1.104(b) requires that the examiner's action be "complete as to all matters", with exceptions not relevant here. MPEP 707.07(f) requires that the Examiner "answer the substance" of any argument made by applicant in traversing the rejection. As noted by MPEP 707.07(g), rejections should be "fully developed", not "a mere conclusion coupled with some stereotyped expression".

The present action is incomplete because, in maintaining the prior art rejections (OA §§15-17), the Examiner fails to address our argument that Melgosa is distinguished by the claim limitation "free of any other chlamydial protein", as made on p.

21 of our last amendment. (This limitation was also ignored in the prior art rejection made by the September 26, 2003 office action.) As we pointed out in the last amendment (p. 21), citing MPEP 2173.06, the fact that this limitation is questioned on 112 grounds does not justify it being ignored in making a prior art rejection.

The Examiner must either (1) explain how Melgosa would satisfy the claim with the challenged limitation, or (2) withdraw the rejections over Melgosa (it is permissible for the Examiner to comment that if the limitation is deleted to overcome the 112 rejection, that the Melgosa rejections will be reinstated). Applicants are entitled to know whether the Examiner agrees that the questioned limitation in fact distinguishes Melgosa; if appeal were taken, the Board would also want to know this.

By failing to specifically address our argument concerning the limitation "free of any other chlamydial proteins", despite the emphasis placed on it by applicants, the Examiner denied applicants "due process", that is, an action complete as to all matters. This denial was compounded by the finality of the action, which circumscribes any attempt by applicant to amend the claims to replace the questioned limitation with one which might be more acceptable to the Examiner.

Respectfully submitted,

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